

Appl. No. 10/796,633
Examiner: DEANE JR. WILLIAM J, Art Unit 2642
In response to the Office Action dated February 24, 2006

Date: May 24, 2006
Attorney Docket No. 10113911

The rejections of claims 1-3, 6, 12-13 and 15-16 are insufficient, insofar as they do not comply with the requirements of MPEP 707.07 et seq., which requires that all rejections be stated with completeness and clarity.

MPEP 707.07(d) requires that the grounds of a rejection be "fully and clearly stated." The office action fails to meet this requirement in the present application in connection with claims 1-3, 6, 12-13 and 15-16.

To anticipate a claim, a reference must teach every element of the claim. In this regard, the Federal Circuit has held:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The rejections of claims 1-3, 6, 12-13 and 15-16 consist of a reference to six figures and four paragraphs of Nagashima and cam 6, cam 8, cam 9, shaft 5 and compression springs 7 and 14 disclosed by the reference. There is no clear statement of any specific teaching in the cited reference of numerous limitations recited in the claims, of which the following are merely representative:

Claim 1: The Examiner makes no clear statement of any specific teaching in the cited reference of the limitations "wherein the second cam rotates along with the first cam when the first cam rotates in the first direction" and "wherein the second cam is blocked by the third cam and is not rotated along with the first cam when the first cam rotates in the second direction."

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Claim 2: The Examiner makes no clear statement of any specific teaching in the cited reference of the limitations "the first cam includes a first curved surface at a side abutted by the second cam, and the first curved surface includes a first portion and a second portion parallel to the first portion, and the second cam includes a second curved surface at a side abutted by the first cam, and the second curved surface includes a third portion and a fourth portion parallel to the third portion, and the first portion and the second portion are engaged with the third portion and the fourth portion, and the first cam automatically rotates to a first predetermined angle by the first portion, the second portion, the third portion, and the fourth portion when the first cam rotates to a second predetermined angle in the second direction due to external force."

Claim 3: The Examiner makes no clear statement of any specific teaching in the cited reference of the limitations "wherein the first curved surface further includes a fifth portion, a sixth portion, a seventh portion, and an eighth portion, and the fifth portion is connected to the first portion, and the sixth portion is connected to the second portion and the fifth portion, and the seventh portion is connected to the second portion, and the eighth portion is connected to the first portion and the seventh portion, and the fifth portion and the seventh portion are conjugate to each other with respect to a central axis of the first cam, and the sixth portion and the eighth portion are conjugate to each other with respect to the central axis of the first cam."

These and numerous other limitations are simply not addressed in the office action. As the office action fails to state with completeness and clarity any teaching or suggestion of at least the limitations noted above, Applicant submits that the rejections of claims 1-3, 6, 12-13 and 15-16 should be withdrawn. Should an ensuing office action be mailed which provides new grounds for the rejections of claims 1-3, 6, 12-13 and 15-16, such an ensuing office action should be made non-final. MPEP 706.07(a).

Nagashima fails to teach or suggest an electronic device wherein a second cam rotates along with a first cam when the first cam rotates in a first direction and wherein the second cam is

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blocked by a third cam and is not rotated along with the first cam when the first cam rotates in a second direction, as recited in claim 1.

Claim 1 recites an electronic device comprising a base, an elastic member, a first cam, a second cam and a third cam. The elastic member is disposed on the base. The first cam is disposed on the base in a manner such that the first cam is abutted by the elastic member. The first cam rotates in a first direction and a second direction opposite to the first direction. The second cam is disposed on the base in a manner such that the second cam is abutted by the first cam. The second cam rotates along with the first cam when the first cam rotates in the first direction. The third cam is disposed on the base in a manner such that the third cam is abutted by the second cam. The second cam is blocked by the third cam and is not rotated along with the first cam when the first cam rotates in the second direction.

Referring to Fig. 3 and paragraph 40 in Nagashima, the push-button 13 is pushed in lightly against a weak resilient force of the second compression spring 14, and at the same time the arresting portions 12a/12a of the slide key 12 slide in the left direction from a state shown in Fig. 3 where they are in engagement with the arresting grooves 8d and 8d, and are thereby released from the arresting grooves 8d and 8d of the inner cam 8 (the alleged second cam), so that the inner cam 8 is made rotatable. The outer cam 9 (the alleged third cam) is kept in the same condition as before, and the top portions 6e and 6e of the convex inclined cam portions 6c and 6c of the slider cam 6 (the alleged first cam) are biased slidably in one direction by the first compression spring 7 (the alleged spring) and are guided by inclined surface portions 9b and 9d of the outer cam 9 to cause a rotation torque to the slider cam 8, thereby rotating with the shaft 5 so that the movable side body 3 is opened automatically.

Thus, the structural relationship between the first cam 6, the second cam 8 and the third cam 9 of Nagashima is different from the first cam, second cam and third cam of claim 1. Namely, claim 1 discloses that the second cam rotates along with the first cam when the first cam rotates in the first direction, and the second cam is blocked by the third cam and is not rotated along with the first cam when the first cam rotates in the second direction. In contrast, Nagashima teaches that when the "second" cam 8 rotates, the "third" cam 9 is kept in the same condition as

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before, and the "first" cam 6 is biased slidably in one direction by the spring 7.

For at least the reasons described above, it is Applicant's belief that Nagashima fails to teach or suggest all the limitations of claim 1. Applicant therefore respectfully requests that the rejection of claim 1 be withdrawn and the claim passed to issue. Insofar as claims 2-16 depend from claim 1 either directly or indirectly, and therefore incorporate all of the limitations of claim 1, it is Applicant's belief that these claims are also in condition for allowance.

Rejections Under 35 U.S.C. 103(a)

Claims 4-5 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagashima. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagashima in view of Oh. Applicant respectfully traverses the rejections for the reasons as follow.

The rejections of claims 4-5 and 7-11 are insufficient, insofar as they do not comply with the requirements of MPEP 707.07 et seq., which requires that all rejections be stated with completeness and clarity.

MPEP 707.07(d) requires that the grounds of a rejection be "fully and clearly stated." The office action fails to meet this requirement in the present application in connection with claims 4-5 and 7-11.

MPEP 2142 reads in part:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in

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the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In connection with the third criteria, MPEP 2143.03 goes on the state:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Contrary to these requirements, the office action merely states that "the cams disclosed by Nagashima are exactly or very similar to those described in the instant application" and "where there is a slight difference in the configuration of the individual cams, it is believed that cams are so notoriously old in the art; it would have been obvious to one of ordinary skill in the art to have configured the cams as deemed necessary in light of Nagashima."

These are not the criteria for establishing a *prima facie* case of obviousness. Where is the suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings? Where is a clear statement that the reference, when modified, teaches or suggests all the claim limitations?

For example, where in the reference does it teach that "the second curved surface further includes a ninth portion, a tenth portion, an eleventh portion, and a twelfth portion, and the ninth portion is connected to the third portion, and the tenth portion is connected to the fourth portion and the ninth portion, and the eleventh portion is connected to the fourth portion, and the twelfth portion is connected to the third portion and the eleventh portion, and the ninth portion and the eleventh portion are conjugate to each other with respect to a central axis of the second cam, and the tenth portion and the twelfth portion are conjugate to each other with respect to the central axis of the second cam" as recited in claim 4? How and why would Nagashima be

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modified to teach these features? The office action offers no guidance in this regard.

For at least the reasons described above, it is Applicant's belief that the office action fails to establish a *prima facie* case obviousness in connection with claims 4-5 and 7-11. Applicant submits that the rejection of claims 4-5 and 7-11 should be withdrawn. Should an ensuing office action be mailed which provides new grounds for the rejection of claims 4-5 and 7-11, such an ensuing office action should be made non-final. MPEP 706.07(a).

Furthermore, as noted above, it is Applicant's belief that claims 4-5, 7-11 and 14 are allowable by virtue of their dependency from claim 1.

The rejections impermissibly distil Applicant's invention down to the "gist" or "thrust" of the invention, disregarding the requirement of analyzing the subject matter "as a whole."

Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole. MPEP 2141.02. It is impermissible to distil Applicant's invention down to the "gist" or "thrust" of the invention, disregarding the requirement of analyzing the subject matter "as a whole." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Applicant submits that by focusing only on the presence of the three cams in Nagashima and the three cams recited in claim 1, and overlooking the many other limitations recited in claims 1-16, the office action distils Applicant's invention down to a gist, and disregards the requirement of analyzing the subject matter as a whole.

Foreign Priority Claim

Acknowledgment of Applicant's claim to foreign priority under 35 USC 119(a)-(d) or (f) and receipt of the certified copies of the priority document(s) is respectfully requested.

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Conclusion

For the reasons described above, the Applicant believes that the application is now in condition for allowance and respectfully requests so.

Respectfully submitted,



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